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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,456	01/23/2004	Steven Frisch	AP-225	6754

7590

08/18/2005

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EXAMINER

NGUYEN, TRINH T

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,456

Applicant(s)

FRISCH, STEVEN

Examiner

Trinh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453, O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13: the phrases "said first relatively longer edge", "said second relatively longer edge", and "said relatively longer" lack proper antecedent basis.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-7, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138; Please see a more detail Figures 1 and 2 of Thum attached with the Office Action for further explanation) in view of Gehret (US 5,572,825).

Thum discloses a glue board and packaging assembly comprising: a first substrate (f); a first adhesive layer deposited on said first substrate; a release member with said release member overlying said first adhesive layer; a second substrate (a); a second adhesive layer with said second adhesive layer in contact with said release member.

Thum lacks release members comprising silicone.

Gehret teaches a similar glue board and packaging assembly as that of Thum in which Gehret discloses that it is old and well known to have a release paper/member comprises a silicone coating so as to use as a protective cover for adhesives to prevent unwanted adhesions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the assembly of Thum so as to include a release member comprising a silicone thereon, in a similar manner as taught in Gehret, since to do so would be used as a protective cover for adhesives to prevent unwanted adhesions.

For claim 2, Thum as modified by Gehret (emphasis on Thum) further discloses said release member comprises a first surface and a second surface with said first surface in contact with said first adhesive layer and with said second surface in contact with said second adhesive layer.

For claim 3, Thum as modified by Gehret (emphasis on Thum) further discloses said release member comprises a thin flexible member, a first release coating (e) deposited on said first surface, and a second release coating (c ) deposited on said second surface.

For claim 4, Thum as modified by Gehret (emphasis on Thum) further discloses said thin flexible member comprises a paper member.

For claim 5, Thum as modified by Gehret discloses most of the claimed invention except for indicating that the thin flexible member comprises a plastic member. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

For claim 6, Thum as modified by Gehret (emphasis on Gehret) discloses most of the claimed invention except for indicating that the silicone is a fluorosilicone. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

For claim 7, Thum as modified by Gehret (emphasis on Thum) further discloses said first substrate and said second substrate each comprise a generally rectangular manner having a first and second relatively layer edge and a first and a second relatively shorter edge.

For claim 13, Thum as modified by Gehret (emphasis on Thum) further discloses said first and said second substrates each further comprise: an area adjacent said first relatively longer edge; an area adjacent said second relatively longer edge; an area adjacent said first relatively shorter edge; an area adjacent said second relatively shorter edge with said areas adjacent said relatively longer and said relatively shorter edges free of said adhesive layers.

For claim 15, Thum as modified by Gehret (emphasis on Thum) further discloses said release member is generally coextensive with said first substrate and said second substrate, and wherein said release member facilitates peeling said first and said second substrates apart.

6. Claims 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Gehret (US 5,572,825), and further in view of Silvey (US 3,025,630).

For claim 8, Thum as modified by Gehret, as described above, discloses most of the claimed invention except for indicating that the first substrate and the second substrate further comprise a plurality of score lines.

Silvey teach a similar assembly as that of Thum as modified by Gehret in which Silvey's assembly includes the teaching of using score lines so that the assembly can be folded to a desirable shape and/or size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum as modified by Gehret so as to include the use of score lines, in a

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similar manner as taught in Silvey, in order to allow the assembly to be folded to a desirable shape and/or size.

For claim 11, Thum as modified by Gehret, as described above, discloses most of the claimed invention except for indicating that the first relatively shorter edge comprises a tab portion having tapered outer edges.

Silvey teach a similar assembly as that of Thum as modified by Gehret in which Silvey's assembly includes the teaching of indicating that the first relatively shorter edge comprises a tab portion (60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum as modified by Gehret so as to include the use of tab portion thereon, in a similar manner as taught in Silvey, in order to realize the benefits thereof. Furthermore, with regarding to the tab portion having tapered outer edges. It is noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the tab portion of Thum as modified by Gehret and further modified by Silvey in whatever form or shape was desired or expedient, wherein applicant did not provide a reason or a stated problem is solved by having the specific shape as claimed versus the shape taught by the prior art. Note that a change in form or shape is generally recognized as being well known within the level to one of ordinary skill in the art depending on one's intended use.

For claim 12, Thum as modified by Gehret, as described above, discloses most of the claimed invention except for indicating a slot formed in the area adjacent to the relatively shorter edge.

Silvey teach a similar assembly as that of Thum as modified by Gehret in which Silvey's assembly includes a slot (50,52) formed in the area adjacent to the relatively shorter edge. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum as modified by Gehret so as to include the use of slots therein, in a similar manner as taught in Silvey, in order to realize the benefits thereof.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Gehret (US 5,572,825), and further in view of Palmeri (US 4,385,465).

Thum as modified by Gehret lacks the first substrate and the second substrate are made of cardboard and/or paper board.

Palmeri teaches a similar assembly as that of Thum as modified by Gehret in which Palmer's assembly includes the substrate made out of cardboard and/or paper board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum as modified by Gehret so as to include the substrate made out of cardboard and/or paper board, in a similar manner as taught in Palmeri, since it is cheaper to use cardboard and/or paper board.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Gehret (US 5,572,825), and further in view of Weil (US 2,328,590).



Thum as modified by Gehret lacks the first surface and the second surface are provided with indicia.

Weil teaches a similar assembly as that of Thum as modified by Gehret in which Weil's assembly includes the surfaces are provided with indicia (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum as modified by Gehret so as to include an indicia on the surfaces of the assembly, in a similar manner as taught in Weil, since to do so would provide some sort of labeling and/or advertising for the assembly.

#### ***Response to Arguments***

9. Applicant's arguments filed 6/13/05 have been fully considered but they are not persuasive.
10. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
11. Regarding Applicant's argument with respect to claim 5 (plastic flexible member), it is noted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, applicant did not provide a reason or a stated problem is solved by having the specific material as claimed versus the material as taught by the prior art. Note that a change in material is generally recognized as being well known within the level to one of ordinary skill in the art depending on one's intended use.

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12. Regarding Applicant's argument with respect to claim 11, Applicant is referred to paragraph # 6 for further explanation.

13. Regarding Applicant's argument with respect claim 14, it is noted that it would have been obvious to one of ordinary skill in the art at the time the invention to apply indicia to any surfaces where it is needed, since it has been held that mere duplication of the essential working parts involves only routine skill in the art. Furthermore, it is noted that in Figure 1, Weil's indicia is on a first surface (14) and a second surface (11).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

The examiner's supervisor, Teri Luu can be reached on (571) 272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Trinh T Nguyen  
Primary Examiner  
Art Unit 3644

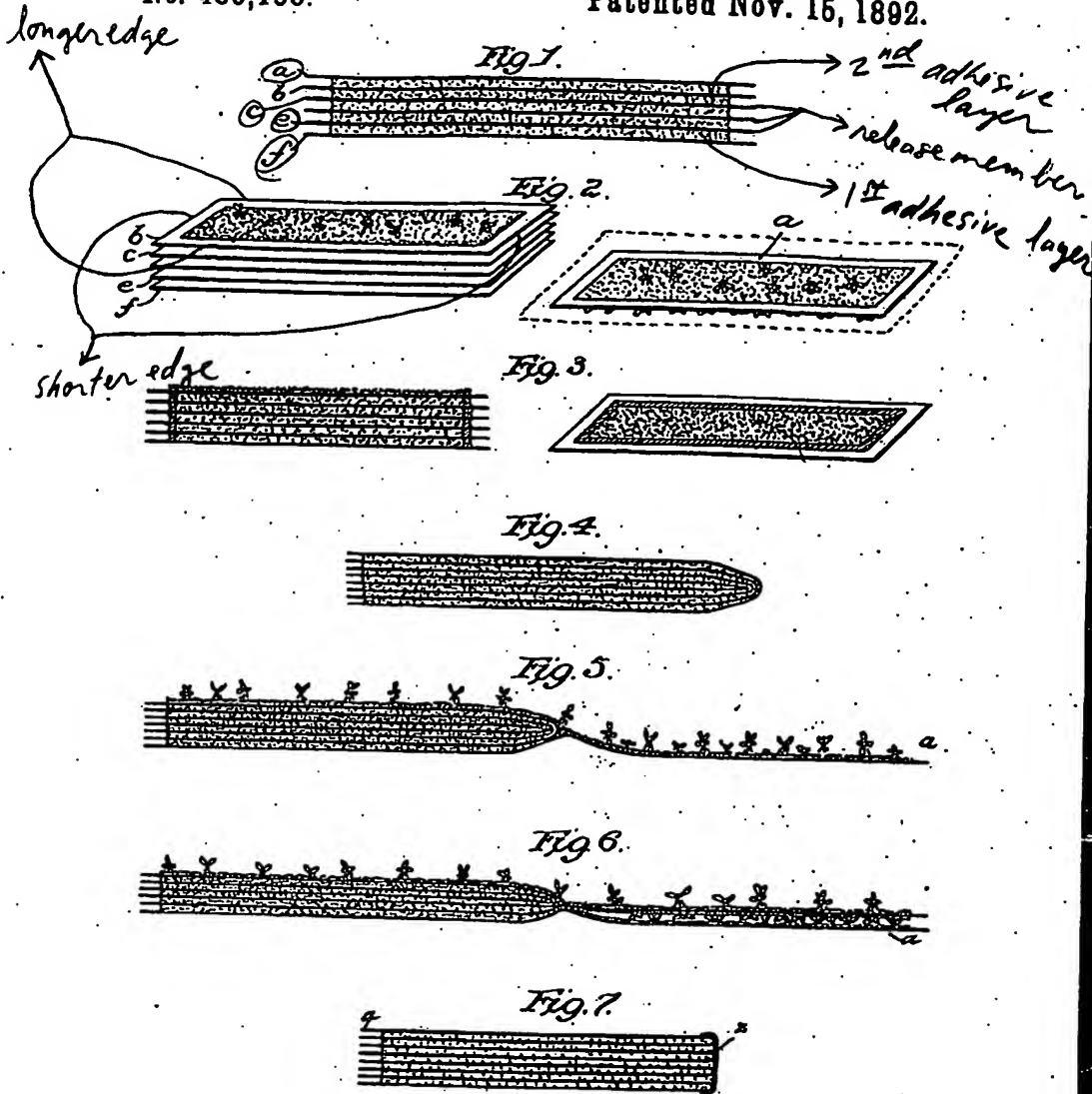
8/15/05

(No Model.)

O. & W. THUM.  
BOOK OF STICKY FLY PAPER.

No. 486,138.

Patented Nov. 15, 1892.



Attest  
William Middleton  
F. L. Middleton

Inventors  
Otto Thum  
William Thum  
by Ellis Spear  
Att'y.